

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on July 12, 2004, the Examiner objected to the specification under 35 U.S.C. §132 and rejected claims 21-29, 31-38 and 40-41 under 35 U.S.C. §112, first paragraph. In the Office Action, the Examiner also rejected claims 21-29, 31-38 and 40-41 under 35 U.S.C. §103(a) as being unpatentable over Evans (U.S. Patent No. 5,924,074, hereinafter “Evans”) in view of Feldon et al (U.S. Patent No. 5,732,221, hereinafter “Feldon”) and Lavin et al (U.S. Patent No. 5,772,585, hereinafter “Lavin”). Applicant expresses appreciation for the Examiner’s Interview conducted on October 19, 2004, which was documented in an Interview Summary that was mailed November 8, 2004, and respectfully provides the following:

Objection under 35 U.S.C. §132

In the Office Action, the Examiner objected to an amendment under 35 U.S.C. §132, indicating that it introduces new matter into the disclosure. In particular, the Examiner indicated that the added material that is not supported by the original disclosure is as follows: The newly added recitation to wherein the step for generating the customizable form comprises: selectively defining display specifications that relate to at least one of (i) a display of the healthcare procedures characteristically performed by the particular healthcare provider and (ii) a display of the healthcare diagnoses characteristically performed by the particular healthcare provider, and wherein the display specifications are based on individual user preferences.

Applicant respectfully references Figures 4A-8 and the corresponding disclosure as representative support for selectively defining display specifications that relate to at least one of (i) a display of the healthcare procedures characteristically performed by the particular healthcare provider and (ii) a display of the healthcare diagnoses characteristically performed by the

particular healthcare provider, and wherein the display specifications are based on individual user preferences. For example, display specifications are defined in Figures 4A-4C that relate to diagnoses and procedures. Further representative support for selectively defining display specifications that relate to at least one of (i) a display of the healthcare procedures characteristically performed by the particular healthcare provider and (ii) a display of the healthcare diagnoses characteristically performed by the particular healthcare provider, and wherein the display specifications are based on individual user preferences is located in the present application as originally filed on line 19 of page 13 through line 14 of page 15. For at least these reasons, Applicant respectfully submits that amendment was in fact supported by the original disclosure and accordingly requests that the objection be withdrawn.

Rejection under 35 U.S.C. §112

In the Office Action, the Examiner rejected claims 21-29, 31-38 and 40-41 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor at the time the application was filed, had possession of the claimed invention and for the reasons set forth in the objection to the specification under 35 U.S.C. §132. The Examiner indicated that independent claims 21 and 33 recite limitations that are new matter, as set forth in the objection to the specification under 35 U.S.C. §132, and that claims 22-29, 31-32, 34-38 and 40-41 are dependent on claims 21 and 33, and incorporate the deficiencies of independent claims 21 and 33.

Applicant respectfully disagrees. As discussed above, reference is made to Figures 4A-8 and the corresponding disclosure as representative support for selectively defining display specifications that relate to at least one of (i) a display of the healthcare procedures

characteristically performed by the particular healthcare provider and (ii) a display of the healthcare diagnoses characteristically performed by the particular healthcare provider, and wherein the display specifications are based on individual user preferences. As an example, display specifications are defined in Figures 4A-4C that relate to diagnoses and procedures. Further representative support for selectively defining display specifications that relate to at least one of (i) a display of the healthcare procedures characteristically performed by the particular healthcare provider and (ii) a display of the healthcare diagnoses characteristically performed by the particular healthcare provider, and wherein the display specifications are based on individual user preferences is located in the present application as originally filed on line 19 of page 13 through line 14 of page 15.

For at least these reasons, Applicant respectfully submits that the amendment was in fact supported by the original disclosure and thus independent claims 21 and 33 as provided herein overcome the rejections made by the Examiner under 35 U.S.C. §112. Furthermore, since independent claims 21 and 33 overcome the rejection made under 35 U.S.C. §112, Applicant respectfully submits that the corresponding dependent claims do not include any deficiencies incorporated therein through dependency and thus the dependent claims also overcome the rejections made by the Examiner under 35 U.S.C. §112.

Rejection under 35 U.S.C. §103

In the Office Action, the Examiner rejected claims 21-29, 31-38 and 40-41 under 35 U.S.C. §103(a) as being unpatentable over Evans in view of Feldon and Lavin. Evans discloses a medical records system that creates and maintains all patient data electronically. The system captures patient data, such as patient complaints, lab orders, medications, diagnoses, and procedures, at its source at the time of entry using a graphical user interface having touch

screens. Using pen-based portable computers with wireless connections to a computer network, authorized healthcare providers can access, analyze, update and electronically annotate patient data even while other providers are using the same patient record. The system likewise permits instant, sophisticated analysis of patient data to identify relationships among the data considered. Moreover, the system includes the capability to access reference databases for consultation regarding allergies, medication interactions and practice guidelines. The system also includes the capability to incorporate legacy data, such as paper files and mainframe data, for a patient. (Abstract)

Feldon teaches a system and method for generating written reports based on succinct input from a user. A method comprises entering a first mode for initialization; defining menus; entering a second mode for receiving information; entering information using the defined menus; interpreting the entered information; and generating a written report in response to the interpreting step. A system comprises a portable computer system having a memory, a processor, a detachable keyboard, a screen, and a pen. Ancillary information is entered with the keyboard which is then detached. Subsequent information is documented by selecting appropriate items from the defined menus; alternatively, the information can be written on the screen with the pen. The processor is programmed to interpret the inputs and generate a report. The report may be printed on a printer, stored on a storage device, and/or transferred to another system. (Abstract)

Lavin teaches method for managing and processing patient medical information in a medical clinic environment. (column 3, line 67 through column 4, line 1)

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that the combination of Evans, Feldon and Lavin does not satisfy a prima facie case of obviousness of the claim set as provided herein since a combination of the references does not teach or suggest all the claim limitations.

For example, independent claim 21 includes limitations relating to using the customizable form to display billing information on a real time basis and prior to the rendering of the one of the procedures on the patient to allow the healthcare provider to advise the patient as to healthcare service to be rendered, including the most cost efficient healthcare alternative for the patient. Independent claim 33 includes limitations relating to rendering the customizable form for use in association with the healthcare provider performing one of the procedures from the pool of healthcare procedures on a patient, wherein the step for rendering the customizable form for use comprises at least one of the steps for: (i) indicating a selection of a diagnosis of the customizable form and (ii) indicating a selection of a procedure of the customizable form, and wherein the step for rendering the customizable form further includes displaying billing information on a real time basis and prior to the performing of the one of the procedures on the patient to allow the healthcare provider to advise the patient as to healthcare service to be provided, including the most cost efficient healthcare alternative for the patient. Such limitations are supported by the present application as originally filed. For example, reference is made to page 5, page 24, page 26 of the application as originally filed. Reference is also made to Figures 10A-10B and the corresponding disclosure.

None of the references that have been cited by the Examiner, alone or in any combination, teach or suggest such limitations. For example, none of the references cited by the Examiner appreciate using a customizable form to display billing information on a real time basis and prior to the rendering of the one of the procedures on the patient to allow the healthcare provider to advise the patient as to healthcare service to be rendered, including the most cost efficient healthcare alternative for the patient. For example, Lavin expressly teaches: "Preferably the appropriate predetermined fee is associated with the selected procedures such that a patient bill may be easily and automatically generated after an office visit." (column 13, lines 56-59)

Applicant respectfully submits that the references cited by the Examiner does not satisfy a prima facie case of obviousness of the claim set as provided herein for at least the reason that no combination of the references teaches or suggests the limitations presently claimed.

Accordingly, since the references do not teach each and every limitation of independent claims 21 and 33, Applicant respectfully submits that neither claim 21 nor claim 33 is made obvious by the references cited by the Examiner. Similarly, since claims 22-29 and 31-32 depend from independent claim 21 and claims 34-38 and 40-41 depend from claim 33, Applicant respectfully submits that claims 22-29, 31-32, 34-38, and 40-41 are also not made obvious by the references cited by the Examiner for at least the reasons provided above.

In fact, the dependent claims are further distinguished from the cited references. For example, dependent claim 22 includes limitations relating to wherein the step for using the customizable form to display billing information is performed during an examination of the patient, and wherein the step for using the customizable form to display billing information includes allowing the healthcare provider to selectively adjust the cost of rendering the one of the procedures at the time of the examination of the patient. Such limitations are supported by the

application as originally filed. For example, reference is made to page 5, page 24, page 26 of the application as originally filed. Reference is also made to Figures 10A-10B and the corresponding disclosure. In contrast, the cited references do not teach or suggest such limitations.

Accordingly, for at least the reasons provided herein, Applicant respectfully submits that the claims are not made obvious by the cited references. Further, since the references teach away from such limitations as presently claimed, there is no need for a new search. Applicant respectfully submits that the claims as provided herein are now in condition for allowance.

CONCLUSION

Applicant respectfully submits that the claim set provided herein does not add new matter and is now in condition for allowance. Accordingly, Applicant therefore requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

Dated this 12th day of November, 2004.

Respectfully submitted,



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